

REMARKS

Claims 1 and 4-11 are pending in the application.

I. TRAVERSE OF THE OBVIOUSNESS REJECTION

The examiner rejected claims 1 and 4-11 as being unpatentable for obviousness over Davies in view Chou et al. (USP 5,322,751).

The examiner takes the position that Davies does not disclose depositing deposition promoting materials by printer transfer mechanism but concludes this is not an issue because “the deposition promoting material is not disclosed in the claim and could be interpreted as any surface treatment” (page 3, second paragraph of Detailed Action) and hence he is entitled to interpret this material as “anything that would promote deposition including chemical/physical etching a metal or anything that comes in contact with the substrate” or even as “any surface treatment”. The examiner’s basis for rejecting the claims is faulty because: (1) all claims require a deposition promoting material; and (2) Chou et al. does not disclose a deposition promoting material as claimed.

A. All Claims Require A Deposition Promoting Material

All of the claims recite a deposition promoting “material”. Indeed, independent claims 1, 8 and 11 all recite:

... depositing magnetic material onto a substrate by means of an electroless deposition reaction in a pattern defined by the prior application of a deposition promoting material to the substrate by a print transfer mechanism, said deposition promoting material facilitating the deposition of said magnetic material from an electroless deposition solution . . .

Clearly all of the claims call for a substrate to which a deposition promoting material has been applied. While an actual material composition is not specified in the claim, it is abundantly clear, by referring to the specification – as the examiner must – that the “deposition promoting material” as claimed must be (i) a material – hence not a physical or electrical form of treating a surface, (ii) of a nature to facilitate the deposition of the magnetic material from an electroless deposition solution – as described for example on page 3, second paragraph of the present application, and (iii) applied by a print transfer mechanism.

B. Chou et al. Does Not Disclose A Deposition Promoting Material

All of the pending claims are non-obvious and patentable at least because Chou et al. does not disclose the claimed deposition promoting **material**. None of the passages of Chou et al. cited by the Examiner disclose a surface treatment with a material having deposition promoting features. On the contrary, column 13, lines 1-23 of Chou et al. describes sensitising a surface by corona discharge for the purposes of electrophoretic deposition (where "electrophoretic" is defined in column 2 of the reference as "relating to the migration of suspended particles in an electric field"). This passage therefore has nothing whatever to do with sensitising **with an applied material** for electroless deposition where a metal is deposited onto a substrate via a chemical reduction process and requires no electric current to drive the process. (See page 2, sixth paragraph of the present application). Neither does this passage refer to a print transfer mechanism. Column 3, lines 1-8 of the reference again refers only to electrophoretic deposits. Column 12, lines 33-68 describes various kinds of substrates, but again only for electrophoretic deposition.

Combining Chou et al with Davies would not therefore result in the method of claim 1 even if it was obvious to the skilled person to make that combination – which it is not since there is no suggestion whatever in Chou et al of using their techniques for fabricating magnetic tags. The same comments apply to independent claims 8 and 11 as well as to all pending dependent claims as they are dependent upon one of claims 1, 8 or 11.

CONCLUSION

Claims 1 and 4-11 are non-obvious and patentable for at least the reasons recited above. Favorable reconsideration and allowance of all pending application claims is, therefore, courteously solicited.

Date: May 2, 2008

By: /A. Blair Hughes/

A. Blair Hughes
Reg. No. 32,901
312-913-2123
hughes@mbhb.com